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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,718	03/21/2001	Paul Schimmel	TSRI 817.0	3346

7590 09/13/2004  
OLSON & HIERL, LTD.  
36th Floor  
20 North Wacker Drive  
Chicago, IL 60606

EXAMINER

NICKOL, GARY B

ART UNIT PAPER NUMBER

1642

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/813,718

Applicant(s)

SCHIMMEL ET AL.

Examiner

Gary B. Nickol Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36,50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36,50 and 51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Re: Schimmel *et al.*

Date of priority: March 21, 2001

The Amendment filed June 14, 2004 in response to the Office Action of 01/12/2004 is acknowledged and has been entered.

Claims 36, 50, and 51 are pending and are currently under consideration.

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.**

***37 CFR 1.131***

The declaration filed on 06-14-2004 under 37 CFR 1.131 is defective since both inventors have not signed the declaration. See MPEP 715.04

**Rejections Maintained:**

Claims 36, and 50 remain rejected under 35 U.S.C. 102(e) as being anticipated by Schimmel *et al.* (US 2003/0017564 A1, February 23, 2001) for the reasons of record in the Action mailed 1/12/2004 and for the reasons set forth below. Applicants argue (Remarks, pages 1-2) that the declaration submitted by Paul Schimmel (which states that prior to February 23, 2001 Paul Schimmel and Keistlke Wakasugi had conceived, prepared, and successfully tested an isolated

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polypeptide consisting essentially of residues 71-471 of SEQ ID NO: 10) obviates the rejection of record. This argument has been considered but is not found persuasive as the declaration is deemed to be defective for the reasons set for above.

Claims 36, and 50-51 remain rejected under 35 U.S.C. 102(b) as being anticipated by Tolstrup *et al.* (Jnl. Biol.Chem. Vol. 270, No. 1 January 1995, IDS) for the reasons of record in the Action mailed 01/12/2004. Applicants argue (Remarks, page 2) that Tolstrup *et al.* only describes full-length TrpRs, i.e. residues 1-147 of SEQ ID NO:10 and thus does not teach or suggest an isolated polypeptide “consisting essentially of” residues 71-471 of SEQ ID NO: 10. This argument has been considered but is not found persuasive as “consisting essentially of” is open language equivalent to “comprising” and thus the prior art still encompasses the claimed peptide. This rejection can be obviated by amending claim 50 to “consisting of amino acid residues 71-471 of SEQ ID NO:10”.

**All other rejections and or objections are withdrawn in view of applicant’s amendments and arguments there to.**

No claim is allowed.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 571-272-0835. The examiner can normally be reached on M-Th, 8:30-5:30; alternate Fri., 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

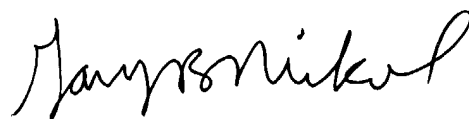
Gary B. Nickol Ph.D.  
Primary Examiner  
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GBN

A handwritten signature in black ink, appearing to read "Gary Nickol". The signature is fluid and cursive, with the first letter "G" being particularly large and stylized.

**GARY NICKOL**  
**PRIMARY EXAMINER**